

No. 12,540

IN THE

United States Court of Appeals
For the Ninth Circuit

JACUZZI BROS., INCORPORATED
(a Corporation),

Appellant,

vs.

BERKELEY PUMP COMPANY (a Corpora-
tion), BERKELEY PUMP COMPANY (a
Partnership), and FRED A. CARPEN-
TER, LANA L. CARPENTER, F. F. STAD-
DELHOFER, ESTELLE E. STADELHOFER,
JACK L. CHAMBERS, WYNNIE T.
CHAMBERS, CLEMENS W. LAUFENBERG
and MARIE C. LAUFENBERG, partners
associated in business under the fic-
titious name and style of Berkeley
Pump Company,

Appellees.

REPLY BRIEF OF APPELLANT.

CHARLES O. BRUCE,

NATHAN G. GRAY,

American Trust Building, Berkeley 4, California,

Attorneys for Appellant.

EDWARD BROSLER,

American Trust Building, Berkeley 4, California,

Of Counsel.

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PAUL P. O'BRIEN,

CLERK

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Appellees.

REPLY BRIEF OF APPELLANT.

This is necessarily a limited reply to a voluminous 83 page brief which constitutes a masterpiece of confusion and, therefore, meets and exposes only the most flagrant of the underlying fallacies thereof.

Preliminary to our specific replies, it should be borne in mind that the patents in suit deal with three different system combinations as outlined and differentiated in our opening brief (pp. 6-12). Defendants, however, make no such differentiation but employ in their brief such veiled, nebulous and confusing terminology as to make difficult, if not impossible, the separate consideration of the three system combinations of the patents in suit.

Care must also be taken not to accept as fact the positive conclusions drawn by defendants from quoted testimony which is either irrelevant or predicated upon assumptions, disregarding features of prior art structures under consideration.

DEFENDANTS' OPPOSITION TO THIS COURT'S DE NOVO CONSIDERATION OF PRIOR ART DOCUMENTS (Dft. Brief, pp. 8-11) IS IRRELEVANT.

In our opening brief (pp. 19-20) we assert and demonstrate that the conflicting findings between the Patent Office and the District Court on the same prior art warrants *de novo* consideration of such art.

The ultimate question of patentability is whether plaintiff's three system combinations meet the requirement of the Statute, 35 U.S.C. 31. The prior art documents are before this Court, they speak for themselves and their interpretation, in view of the statute, is as open to this Court as to the District Court or the Patent Office.

De novo consideration imparts, not a review of the District Court's findings but a determination "anew" of whether, under the statute, these prior art documents disclose on their face the inventions of plaintiff's patents to be old. Therefore, defendants' unsupported assertion that our position is untenable is without pertinence. Lest this portion of their brief be nude of authority, they cite certain cases which merely hold that the presumption of validity arising from the grant of a patent is weakened where pertinent prior art had not been considered by the Patent Office. These cases do not deal with the issue presented by us.

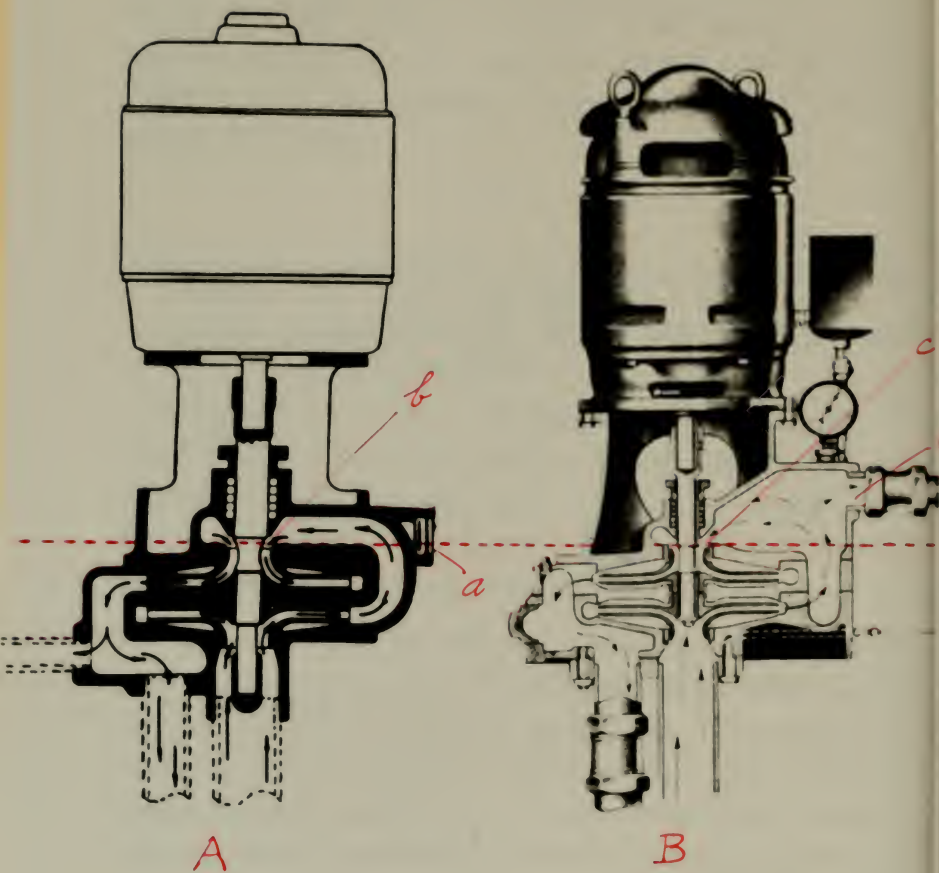
In this case the most pertinent art had been considered by the Patent Office, for those not so considered either lacked pertinence or were presumptively considered, since they add nothing to the art, being mere duplication of those features of the art which had been considered. Thus the patents to SULZER (R. 561), RATEAU (R. 564) and STEPANOFF (R. 569) are merely cumulative of the disclosures of ENSSLIN (R. 575) and HILLIARD (R. 618) which the Patent Office had considered. The patent to R. JACUZZI (R. 579) took its service discharge from the suction line and the District Court found such arrangement fraught with difficulties (Decision, R. 62). The Italian patent to VERONESI, 1913 (R. 545) and the German patent to SPECK (R. 591) supply the service line and injector from different sets of impellers in parallel and this ar-

arrangement the Court found was less desirable than a system where the impellers were in series (Decision, R. 62, 63). The effect of parallel arrangement of impellers is that of two separate pumps and VERO- NESI in his specification so designates them (Translation at R. 602).

DEFENDANTS' CONTENTION (Dft. Brief, pp. 12-16) THAT THE "PUMPS" IN ISSUE REPRESENT NO MORE THAN A NORMAL ADVANCE IN PUMP DESIGN AND A STEP BY STEP DEVELOPMENT, IS REFUTED.

Defendants' alleged historical development is created as a convenient vehicle to support erroneous conclusions, since deep well systems, as shown by the record, were in existence long prior to any lowering of the water table in California.

Plaintiff's systems are not the outgrowth of any lowering of water table. Thus plaintiff's system Combination A (Ptf. Opening Brief, pp. 8-9) solved a problem which existed in all previous deep well injector systems employing a single centrifugal pump; while system Combination B (Ptf. Opening Brief, pp. 10-11) is not even dependent upon deep well operation but functions equally well in shallow well installations which employ no injector; and system Combination C (Ptf. Opening Brief, pp. 11-12) involves an inherently stable, self-balancing system eliminating the need of troublesome control valves, which solved a problem existing from the first injector type system whether pumping from 30 feet or 600 feet.



DEFENDANTS' ILLUSTRATION (Dft. Brief, p. 15) WITH ADDED DISCHARGE IS NOT THE SAME AS THEIR ACCUSED PUMPS.

Defendants state with respect to such illustration: "The red colored addition was the only change made to change it from a non-accused pump to an accused one." Such statement is a misrepresentation and is so shown to be by the comparative illustration on the opposite page wherein a portion of defendants' illustration, but with the red addition shown in black, is pictured alongside a corresponding portion of one of their accused systems (Fig. 36, Ptf. Exh. 13, R. 515). Reference to the dotted line passing through both illustrations shows that in their early pump A as modified but never built, the low pressure discharge "a" is favored over the input "b" to the upper impeller, while in the accused system B, or the one actually built, the pump casing has been redesigned to favor the input "c" to the upper stage over the low pressure discharge "d", or just the reverse of the former.

The importance of the foregoing difference, "apparently" overlooked by defendants' brief, is recognized by their witness CARPENTER in his testimony.¹

¹"Q. In effect, what you do, you design to construct the casing of your pump in such a manner that the discharge to service from the low-pressure side of the pump is always at a higher point than the intake of the second impeller?

A. Why, yes.

Q. In other words, your construction is such as to favor the second impeller?

A. I guess that is as good a way to put it as any." (R 374)

**DEFENDANTS' EXHIBIT A (Dft. Brief, p. 17) IS A HYBRID
CREATION AND NEVER EXISTED.**

Exhibit A is a hypothetical arrangement created in part upon assumptions during cross-examination of the witness JACUZZI. Defendants assert that this witness testified (Dft. Brief, p. 23) that the system of Exhibit A was built and used long prior to 1940. However, what this witness ultimately said was: "I have never seen pumps installed that way * * *" (R. 170).

**DEFENDANTS' ILLUSTRATIONS (Dft. Brief, p. 18) INCLUDE MIS-
LEADING AND ERRONEOUS NOTATIONS UPON WHICH
THEIR ARGUMENTS ARE PREMISED.**

Defendants' notation on said illustrations that the only difference effected by the inventions is the lowering of the discharge outlet to produce, as a result, a lower discharge pressure, apparently overlooks the fact that in both figures the discharge is taken from the third stage.

Defendants' notation under Fig. 34A that such "pump" embodies the alleged inventions of both patents in suit is incorrect, for obviously it does not embody the dual purpose pressure system of Combination B (Ptf. Opening Brief, p. 10) with its attendant advantages. The system combinations which Fig. 34A includes are inventively distinct from the prior system of Fig. 24A in providing a system wherein the internal pump structure is such as to

favor at all times the flow of water to the jet as against the discharge to service, thus providing a self-balancing and highly stable system and the elimination of a control valve; none of which features or their equivalents are found in Fig. 24A.

The disclosure of Fig. 24A is that of the F. JACUZZI patent (Dft. Exh. T, R. 584) which the Patent Office cited and found wanting as anticipatory of the inventions of each of plaintiff's patents.

HORIZONTAL MULTI-STAGE CENTRIFUGAL PUMP UNITS OF THE PRIOR ART ARE NEITHER SELF-BALANCING NOR INHERENTLY STABLE AS DEFENDANTS CONTEND.

The expression "self-balancing" is descriptive of the *cooperative relationship* existing in plaintiff's system Combination C, *between the injector and the centrifugal pump* unit, whereby the mutual reaction of the one upon the other precludes the system from stalling under adverse conditions.

Defendants' contention (Dft. Brief, pp. 28 and 29) that multi-stage centrifugal pumps, as such, are "self-balancing" is a misnomer and contrary to the testimony of their own expert FOLSOM who never did state that the alleged gravity separation in pumps such as SULZER (R. 561) and RATEAU (R. 564) makes the pumps "self-balancing" and assures full high pressure output with full opening of the low pressure discharge. In fact, his testimony is directly

to the contrary,² and not only confirms the patent disclosures themselves,³ but supports the Court's finding⁴ on this point.

Defendants' contention (Dft. Brief, p. 77) that such pumps can be employed *without change* in an injector system by merely connecting an injector to the high pressure discharge, is not only refuted by the factors discussed both above and in plaintiff's opening brief (pp 39-43), but defendants have offered no evidence on this point although the burden was theirs.

The danger of accepting such conjectural conclusions without proof is strikingly demonstrated by an analysis of the RATEAU pump which discloses a multi-stage centrifugal pump in which the upper stages are operatively associated with the low pressure stages through a clutch arrangement. With an injector added to the high pressure discharge end, the injector will be effectively disconnected upon de-clutching of the upper stages as taught by the patent. The result—*an inoperative system*.

²“Q. Assuming both impellers are being driven in the Rateau patent, P, the suction enters the inlet of the first stage, is that correct?”

A. That is right.

Q. And maintaining that assumption, would any fluid discharged from the first stage enter the inlet of the second stage?

A. *The amount of fluid entering the second stage depends on the condition of the control valve 37.*” (R 288-289)

³“In the operation of the pump when the fluid is to be lifted to its greatest height the valve 37 of the discharge-pipe 35 is closed, and the valve 38 of the pipe 36 is opened.” (R 56SA)

⁴“But of the specific models brought to the Court's attention, none were designed specifically to supply water at different pressures simultaneously.” (R 58)

THE VERONESI 1913 ITALIAN PATENT WAS FOUND
IRRELEVANT BY THE DISTRICT COURT.

Identity of mode of operation of the VERONESI 1913 Italian patent (R. 545) to either defendants' accused systems or any of plaintiff's system combinations has never been established.

The testimony of defendants' witness, Dr. FOLSOM, relied on by defendants as establishing such identity of mode of operation, proves nothing in this connection, and for two potent reasons, either of which suffices:

1. Dr. FOLSOM'S understanding of "mode of operation" was strictly limited to the increasing of pressure through the action of a centrifugal pump, and not to system combinations as here involved. He testified:

"* * * The mode of operation, *which is an increase in pressure through the action of the centrifugal pump*, occurs in both of the centrifugal pumps, the difference is in the arrangement."
(R. 324.)

Thus, so long as it utilizes a centrifugal pump, every water system would embody the same mode of operation. Based on this mistaken premise, defendants propound that the obviously different systems of the prior art each embody exactly the same mode of operation, and this in the face of their admission that differences in structure and arrangement exist.

Moreover, the testimony of Dr. FOLSOM relied on by defendants (Dft. Brief, pp. 37-38) clearly shows

that this witness was furthermore testifying relative to an incomplete and hypothetical system, for the VERONESI 1913 patent served merely as a basis for building a mythical system in the question propounded to Dr. FOLSOM who was careful to allow for the differences, in his answer.⁵

By analogy, if color is disregarded, it may be stated that there is no distinction between a Negro and a Caucasian.

Defendants stress (Dft. Brief, p. 37) that Dr. FOLSOM'S testimony was not contradicted and is the only testimony. Since this testimony neglects the essence of the reference, any contradiction was obviated.

2. In defendants' comparison of this Italian (1913) patent with their accused pump system (Dft. Brief, p. 40) they resort to the use of inaccurate terminology broad enough to cover different structures and arrangements. Thus, under their word breakdown of the VERONESI structure, "a multi-stage centrifugal pump" should read—a *pair* of multi-stage centrifugal pumps—(see translation of VERONESI (1913) Specification at R. 602); and the remainder of the breakdown should be corrected to

⁵“Q. Thank you, Doctor. Now, Doctor, *disregarding the fact that the water is divided between the high pressure and the low pressure portions of the pump in the Italian patent, M*, is there any *substantial* difference in the mode of operation between the pumping system shown in that Italian patent and the mode of operation in the Berkeley pump (the accused pump) shown in Exhibit 5? (parenthesis added)

A. *Neglecting the details of the arrangement of the centrifugal pump*, the pump system is the same.” (R 303)

specify that the water entering the suction line of the VERONESI 1913 pump divides before it enters any stage of either of the pair of pumps, and, further, that there is *no favoring* of the supply to the injector (an important factor in the consideration of the inventions here involved).

Thus corrected, it is manifest that, far from being the same systems, the systems compared are decidedly different, as the District Court itself found (Dec., R. 62-63):

“In the Italian patent number 139,161 to Veronesi and the German patent number 376,684 to Speck the single service line and the injector are supplied from different sets of impellers in parallel on a single shaft. The extra number of impellers required for this arrangement should make it less desirable, however, than a system in which the pump impellers are in series.”

The aforementioned adverse finding represents the sum total of the consideration given to these two irrelevant foreign patents by the District Court in its decision.

Defendants' quotation (Dft. Brief, p. 41) is not only incomplete, but a misquote (see Ptf. Opening Brief, p. 46), and reference to plaintiff's brief shows that we commented on the VERONESI 1913 patent and referred to the Court's adverse finding with respect thereto.

There is no finding by the District Court that it would not involve invention to substitute a *single*

prior art multi-stage centrifugal pump for the *pair of parallel connected* multi-stage pumps of the VERONESI 1913 patent, as inferred by defendants (Dft. Brief, pp. 41-42). Furthermore, Findings 12, 27 and 28, relied on by defendants in support of such contention, are wholly irrelevant and lacking in pertinence.

Defendants' contention, that *Crowell v. Baker Oil Tools*, 153 Fed. (2d) 973, is the last expression of this Court on the admissibility for purposes of anticipation of the non-noticed or pleaded VERONESI 1913 patent, overlooks the later case of *Blanchard v. J. L. Pinkerton, Inc.*, 77 Fed. Supp. 861, which was affirmed, 173 Fed. (2d) 573, by this Court upon the grounds stated in the opinion of the lower Court.

DEFENDANTS' WORD COMPARISON BETWEEN THE VERONESI 1927 PATENT AND THEIR ACCUSED PUMPS (Dft. Brief, pp. 46-47) IS UNSOUND.

Defendants' word comparison between the VERONESI 1927 patent and their accused pumps is based solely upon defendants' interpretation of the incomplete and ambiguous foreign patent drawing, and disregards and violates the teachings of the specification. Such comparison is further in error as to Paragraph "h", in that the conclusion as to self-balancing is totally unsupported by R. 305 which defendants cite. The conclusion in Paragraph "i" further finds no support in the incomplete disclosure of the VERONESI patent, since that portion of the VERONESI system,

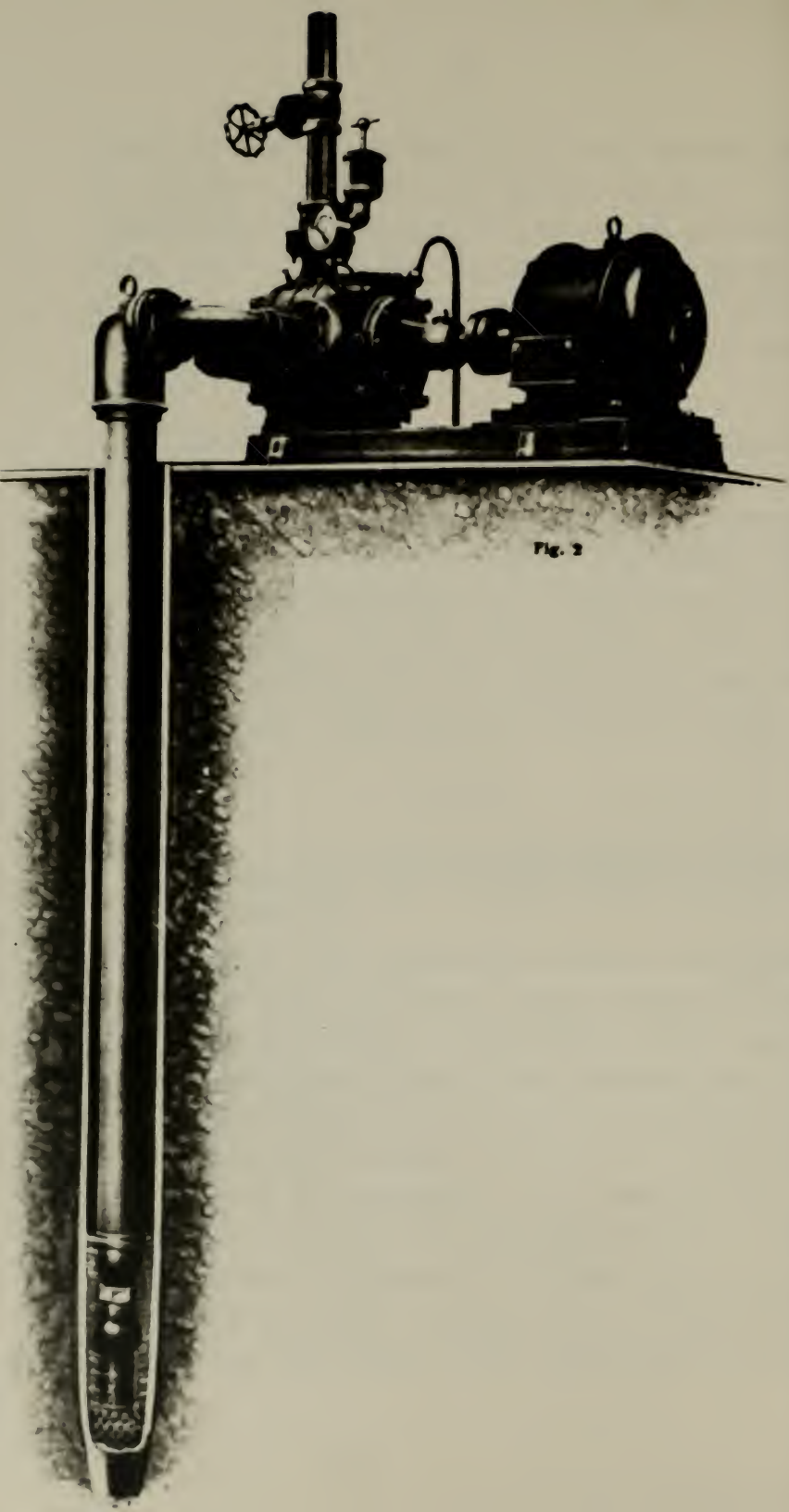


Fig. 2

namely the service line which would indicate the presence or absence of a control valve, is not even included in the disclosure. Defendants' conclusions, therefore, under both Paragraphs "h" and "i" are mere assumptions, not based on fact or supported by the record.

The danger of accepting such statements as facts is strikingly demonstrated by defendants' own Exh. AG, from which, on the opposite page, we reproduce Fig. 2 thereof. Such figure shows the VERONESI 1927 pump system *with a control valve* in the service discharge line and utterly refutes defendants' baseless assumption that said reference system is inherently self-balancing and requires no control valve.

Furthermore, the presence of a control valve in the discharge line accords with the teachings of the VERONESI 1927 specification (R. 606) which has been the conventional practice for years and is illustrated in the system involved in the prior art patent to F. JACUZZI (R. 584).

DEFENDANTS' CONTENTION THAT PLAINTIFF'S WITNESS ARMSTRONG AGREES WITH THEIR INTERPRETATION OF THE ITALIAN (1927) PATENT DRAWING IS REFUTED BY THE RECORD.

Defendants' conclusion (Dft. Brief, p. 47) that plaintiff's witness ARMSTRONG agrees with defendants' witnesses FOLSOM and LAYNE that their interpretation of the VERONESI 1927 patent draw-

ing is the logical construction, is incorrect, in that the testimony quoted and relied on relates to an *assumed* construction and not to the structure of the VERONESI 1927 patent drawing which even the District Court found (Dec., R. 63) pictures no passage. What defendants have actually done is to assume a hypothetical structure and create the impression that ARMSTRONG'S answers to the hypothetical structure apply to the actual showing of the patent drawings. What the witness ARMSTRONG said with respect to the disclosure of the VERONESI 1927 patent was that there was nothing on the drawing to indicate a flow passage to the service discharge:

“Q. Is there anything on the drawing, Exhibit N2, which indicates to you how the water gets to discharge 9?

A. No.” (R. 465.)

THE ILLUSTRATION OPPOSITE PAGE 46 OF DEFENDANTS' BRIEF IS AN ALTERATION OF ONE VIEW OF THE VERONESI 1927 PATENT DRAWING TO SUIT DEFENDANTS' INTERPRETATION OF THE DRAWING IN UTTER DISREGARD AND VIOLATION OF THE TEACHINGS OF THE PATENT SPECIFICATION.

The title of such illustration should not be confused with the actual drawing of Exhibit N, for it constitutes a revision and alteration of only one figure thereof to suit defendants' interpretation of what they thought the patent drawing ought to mean.

Figure 1 of the VERONESI patent drawing pictures no passageway such as noted by defendants,

nor do the dotted lines, which they have added without comment to such illustration to indicate such a passageway, appear in the original patent drawing. Defendants' witnesses could only interpret the ambiguous patent drawing, but VERONESI, the patentee, did not have to interpret—he knew—and so stated in his specification. The language of the VERONESI specification was not construed or even referred to by defendants' witnesses and, while fully discussed in plaintiff's opening brief, has not been refuted or explained by defendants in their brief. Such language is, therefore, controlling.

The fact that the service discharge in the VERONESI 1927 structure is located above the first stage and at a distance from the last stage of the pump unit is not uncommon practice for, even in the limited art of record, we have two examples of such practice—one in plaintiff's F. JACUZZI patent (R. 584) where the water is divided at the last stage, as taught by the VERONESI specification, and a portion of it is taken out at the opposite or lower end of the pump housing.

The other example is represented by the practice of defendants in their fire fighting pump (Ptf. Exh. 22, Fig. 72, R. 533) shown in section in Fig. 74 (R. 534) wherein the water from the end stage 7 is taken out of the pump housing above the second stage through the discharge flange 13 (shown in dotted lines).

By a separate three-dimensional drawing (Ptf. Exh. 21), plaintiff has illustrated how a similar prac-

tice could be obtained in the VERONESI 1927 pump structure in accordance with the teachings of his specification. This drawing has been attacked upon the ground of being deceptive in the minor particular of a line which had nothing to do with the flow passages from the last stage to the discharge. Such flow passages satisfy the teachings of the VERONESI specification and have not been refuted.

As to the minor detail of the drawing under criticism by defendants, defendants quote only selected portions of the witness ARMSTRONG'S testimony, in utter disregard of his immediately subsequent testimony nullifying the alleged discrepancy and establishing, by means of an explanatory sketch (Ptf. Exh. 23), the accuracy of the drawing.⁶

THE FACTS AS FOUND BY THE TRIAL COURT AND THE FACTS SHOWN BY THE RECORD, AS RELIED ON BY DEFENDANTS, FAIL TO SUPPORT THEIR CONTENTIONS (Dft. Brief, pp. 52-56) THAT PLAINTIFF'S INVENTIONS ARE FOR OLD COMBINATIONS.

To intelligently discuss any issues relating to the inventions of plaintiff's patents, the three system Combinations A, B and C (Ptf. Opening Brief, pp.

“Q. You actually show a line at the bottom of that boss which you said they contact?

A. Well, it would show a line.

Q. So you would have to add not only the ordinary thickness of half the boss, but you have to then add another wall, don't you?

A. No, I didn't add any other wall. I am telling you that is a shade line to show you that is round and also to show this passage which comes from the annular end.” (R 474)

8-16) must be considered as separate and different inventions and they cannot be merged into a single invention by the indiscriminate use of all-embracing and vague terminology such as "pump", "step", "combination" and the like.

Defendants' arguments for this reason are vague and uncertain and their conclusions unsound. Also contributing to the confusion is the error of the District Court's Findings 24 and 25 (R. 85) in looking to the claims of a patent for an expression of the intent and purposes of the inventions involved, and many errors of defendants' argument lie in adopting the Court's error as their premise.

It is fundamental in the drafting of patent applications to particularly recite the objects and purposes of the invention. This should not be confused with the claims which measure the scope of the invention and merely recite the structure for carrying such objects and purposes into practice.

Walker on Patents, Deller's Ed., Vol. II, page 710;

Patentability and Validity, Rivise & Caesar, Sec. 185, page 345.

The objects of the system combinations of patent 285 are set forth in the lower half of column 1, page 1 of such patent (R. 499), and of patent 958, in the top half of column 2, page 1 thereof (R. 506).

Defendants' reliance (Dft. Brief, p. 53) on the District Court's Finding 16 (R. 82) to anticipate all of plaintiff's system combinations, is not supported

by such finding which says nothing regarding the relevancy of the VERONESI (1913) patent to any of plaintiff's combinations. In fact, defendants admit (Dft. Brief, p. 53) the lack of relevancy of the VERONESI (1913) patent in stating it discloses the complete "combination" of plaintiff's two patents as claimed, *except* for the fact that the impellers are in parallel rather than in series. Thus, what defendants actually contend discloses the combination is not the system of the VERONESI (1913) patent, but some hypothetical unknown, obtained by disregarding the very features which characterize the reference system.

Defendants' reliance (Dft. Brief, p. 54) on the District Court's Finding 17 (R. 82) to establish relevancy of the SPECK (German) patent (R. 591) to plaintiff's system Combinations A, B and C, fails for like reason, for Finding 17 has nothing to say regarding any of plaintiff's patented system combinations. In fact, the District Court found that the very structure which defendants and their expert FOLSOM disregarded is that which led the Court to remove these foreign patents from further consideration.⁷

Defendants further rely (Dft. Brief, p. 55) on the District Court's Finding 46 (R. 91) as holding all of

⁷In the Italian patent number 139,161 to Veronesi and the German patent number 376,684 to Speck the single service line and the injector are supplied from different sets of impellers in parallel on a single shaft. *The extra number of impellers required for this arrangement should make it less desirable, however, than a system in which the pump impellers are in series.*" (Dec., R 62-63)

plaintiff's patented system combinations anticipated by the two parallel disposed pumps of the VERO- NESI (1913) patent, or the equivalent thereof of the SPECK (German) patent. This further attempt to parade these two foreign patents as disclosures of the various system combinations of plaintiff's patents must also fail, in that Finding 46 does not even mention these foreign patents.

DEFENDANTS' CONTENTION (Dft. Brief. p. 57) THAT THE DISTRICT COURT'S FINDINGS 41 AND 42 ARE FINDINGS OF INVALIDITY BECAUSE THE CLAIMS ARE FUNCTIONAL, AMBIGUOUS AND INDEFINITE UNDER R. S. 4888, IS ERRONEOUS.

There exists no basis in the record to support defendants' contention that the claims of plaintiff's patents are either functional, ambiguous or indefinite, nor did the District Court so state in its findings. Findings 41 and 42 embody no such language, whereas the District Court's reference therein to structure is a clear designation that the findings relate to the scope of the claims.

R. S. 4888 imposes no limitation or restrictions as to scope of claims, this being determined in the light of the prior art. Thus, as stated by *Walker on Patents*, Deller's Ed., Vol. II, page 770:

“The claims are the creature of statute in which the inventor is required to particularly point out and distinctly claim his invention. (White v. Dunbar, 119 U.S. 47, 51.) It is in the

claims therefore that the inventor secures his protection, and such claims should therefore be drawn with great care and *as broad as possible, consistent with the state of the art.*"

And again on page 1245:

"* * * a claim is not required to be limited to exact device disclosed by specification and drawings, since the claims of patent and not its specifications measure the invention."

Defendants apparently overlook the fact that plaintiff in its opening brief (pp. 44-45) specifically argues Findings 41 and 42.

CONTRARY TO DEFENDANTS' CONTENTION OF DOUBLE PATENTING, THE DISTRICT COURT FOUND A LINE OF DIVISION EXISTED BETWEEN THE CLAIMS OF THE TWO PATENTS IN SUIT, AND THE RECORD FULLY ESTABLISHES THE ERROR OF DEFENDANTS' CONTENTION.

The defendants (Dft. Brief, p. 69) isolate and consider the latter part of the District Court's Finding No. 6, and disregard the preceding part thereof which gives meaning to the finding as a whole. Thus the part *ignored* by defendants in arriving at their conclusion of double patenting is italicized as follows:

"6. *The claims of the two patents in suit fail to express clearly the line of division between them, and one must resort to the specifications to determine it; for example, claim 13 of patent No. 2,424,285 in substance is identical with those claims in patent No. 2,344,958 which do not*

specify that the discharge opening to service is valve free.”

The defendants in their analysis of Claim 13 of patent 285 with Claim 5 of patent 958, acknowledged (Dft. Brief, p. 71) certain differences to exist, which differences the Patent Office had recognized among other things as determining the line of division between the inventions of the two patents in suit.

Defendants have apparently overlooked the discussion in plaintiff's opening brief of the history of the patents in suit, which establishes the non-existence of double patenting as well as the obvious error of the finding as misconstrued by defendants. As we have pointed out in our opening brief, pages 7-8, the applications of the two patents were *co-pending*; that patent 958 is a *continuation-in-part* of patent 285; that the Patent Office required and the patentees maintained a *line of division* between the claims of the two patents; that while simultaneous issuance of the patents was requested, the allowance of the application of patent 285 was *unavoidably* delayed beyond the grant of patent 958 because of the Interference between the application of patent 285 and defendants' RHODA patent. Thus the issue of double patenting had been thoroughly considered and settled by the Patent Office, and the subsequent issuance of the patents is a finding that the claims of such patents are not for the same invention.

The question of determining when improvements should be embraced in a number of patents presents

a difficult problem and should be left to the Patent Office.⁸

Since the claims of the two patents are admittedly different, it makes no difference in which of the two co-pending applications the generic claims appear and such claims may issue last as they did in patent 285, since generic claims were first to appear in such patent before the issuance of patent 958.⁹

Defendants surprisingly announce in effect (Dft. Brief, pp. 74, 75) that it is beyond their comprehension how their accused systems could infringe both patents in suit unless such patents cover exactly the same invention. Defendants apparently overlook the established law in this respect as set forth by *Walker on Patents*, Deller's Ed., Vol. III, page 1692:

⁸" . . . However, and even though the applicant may appeal from a ruling of the Patent Office, he cannot 'justly be blamed for acquiescing in a command by lawful authority, much less can he properly be made to suffer loss by obedience.' American Laundry Machinery Co. v. Prosperity Co. (C.C.A.) 295 F. 819, 821. Furthermore, as was said in that case: 'It being "difficult, perhaps impossible," to lay down general rules determining when improvements should be embraced in "one, two or more" patents, discretion must be left to the Patent Office on this "nice and perplexing question."'"

National Tube Co. v. Steel & Tubes, 90 F. (2d) 52, 54 (CCA 3, 1937).

⁹"When a patent has issued, no subsequent claim by the patentee can be valid for the same invention; but if the claims be different, and the applications are pending concurrently, it makes no difference in which of the two applications the broader claims appear, and the generic claims may issue last, unless they were for the first time introduced into the application after the first patent issued. (*Kaplan v. Robertson*, 50 F. (2d) 617, 621, D.C. Md. (1931).)"

Walker on Patents, Deller's Ed., Vol. II, page 771.

“A device which embodies the principles of a basic patent as well as one for an improvement infringes both.” (Citing cases.)

See, also:

Patentability and Validity, Rivise & Caesar,
Sec. 321, page 604.

THE INTERFERENCE INVOLVING PLAINTIFF'S PATENT 285
AND DEFENDANTS' RHODA PATENT STRENGTHENS THE
ORDINARY PRESUMPTION OF VALIDITY OF PLAINTIFF'S
SAID PATENT.

The voluminous file wrapper of over 150 pages of the Interference (Dft. Exh. D) is a forceful contradiction of defendants' assertion that “appellees did not engage in expensive or any interference.” Furthermore, defendants thought enough of the invention involved in Claim 11 of plaintiff's patent 285 to draft said claim and secure its issuance in their own RHODA patent. It is significant that notwithstanding the extensive urging of invalidity of the invention of Claim 11 by defendants in the Interference, the Patent Office continued to recognize the irrelevancy of the VERONESI (1927), SCHMID and HILLIARD references by passing plaintiff's patent 285 to issue.

Defendants apparently overlook the fact that this Interference and the subsequent action of the Patent Office, together with their own prior conduct and admissions, serve to materially strengthen the ordinary

presumption of validity of plaintiff's patent 285. The question of estoppel is not involved and defendants' citations thereon are without pertinence.

CONCLUSION.

We respectfully urge that the judgment of the District Court be reversed and judgment be ordered for plaintiff as prayed for in its complaint.

Dated, Berkeley, California,
November 9, 1950.

Respectfully submitted,

CHARLES O. BRUCE,

NATHAN G. GRAY,

Attorneys for Appellant.

EDWARD BROSNER,
Of Counsel.